

REMARKS

Claims 1-25 are pending in the Application.

Claims 1-25 stand rejected.

Applicants greatly appreciate the time and effort expended by the Examiner and the Examiner's supervisor, Mr. Fan Tsang, discussing the sufficiency of the declarations filed by Applicants on March 19, 2004 to overcome the rejections based on the McCormack reference.

In Paper No. 7, the Examiner asserted that the Declaration under 37 C.F.R. § 1.131 was ineffective to overcome the McCormack reference since the evidence for showing conception did not show any dates. However, the Examiner and Examiner's supervisor agreed with Applicants' attorney that such dates could be redacted by Applicants.

Mr. Tsang agreed in the telephone conversations with Applicants' attorney that response to Paper No. 7, including any newly submitted declarations would be considered by the Examiner, with such response intending to further support the assertion by Applicants that they had conceived of the invention recited within the claims previous to the McCormack reference, and had reduced the invention to practice constructively with due diligence.

Further, within Paper No. 7, the Examiner has asserted that Exhibits A and B supporting the conception prior to the McCormack reference do not support all of the limitations of claims 1-25. Applicants respectfully assert that as long as certain ones of those claims are removed as prior art by swearing behind the McCormack reference, then the Examiner must remove the rejection of those particular claims. In other words, it is not an all or nothing proposition. Each claim within a patent application is to be viewed as a separate embodiment of the invention. If Applicants are able to show conception of the invention recited within any independent claim, even though there may be insufficient evidence to show full conception of embodiments within claims dependent upon that independent claim, since the

independent claim has been removed, the rejection of all of the claims, both independent and dependent, must be removed. 37 C.F.R. § 1.131 recites that “When any claim of an application... is rejected, the inventor of the subject matter of the rejected claim... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.” The Examiner is respectfully requested to note that 37 C.F.R. § 1.31 does not state that the declaration must establish invention of the subject matter of all rejected claims prior to the effective date of the reference. MPEP § 715.02 also states that the “declaration must establish possession of either the whole invention claimed or something falling within the claim.” MPEP § 715.03 states that the “declaration under 37 C.F.R. § 1.31 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.” Therefore, it is clear that the law and the MPEP do not require that all claims be shown to be supported by the evidence for swearing behind a reference, but that any one particular claim can be shown to have been conceived of prior to the critical date of the reference. Further, the MPEP permits a generic claim, such as an independent claim, to be proven as having been conceived of prior to a prior art reference.

Exhibit B previously provided by Applicants for proving conception, states that it is for improving customer satisfaction during holds on WAP phones, with WAP referring to the Wireless Application Protocol enabled for cell phones. Claim 1 recites that it is a method within a digital wireless telecommunications network. Use of a cell phone with a WAP protocol is performed within a digital wireless telecommunications network. Exhibit B further describes how content can be pushed or downloaded to the user's WAP phone while the user is placed on hold. This clearly discloses the step of a voice call being received from a user of a cell phone, since a user would have to have made or received a voice call on their cell phone to be put in a hold state. Further, it would be obvious that a user would conduct a voice conversation with the received voice call. Further, claim 1 recites that while the voice

call is continuing (in other words, a voice call continues during the process whereby the user is placed in a hold state), content is downloaded to the cell phone for display on a display screen of the cell phone. Claim 3 recites that this is done while the voice call is in an on hold status. Exhibit B discloses this step by describing that content is pushed to the user's microbrowser on their cell phone while the customer is in an on hold state.

The Examiner is respectfully requested to note that MPEP § 715.02 states that Applicants can still overcome the rejection by showing that the differences between the claimed invention and the evidence provided to overcome the reference would have been obvious to one of ordinary skill in the art, because Applicants' possession of what is shown carries with it possession of variations and adaptations which would have been obvious at the same time to one of ordinary skill in the art. It was obvious at the time of March 21, 2001 that cell phones had displays and microbrowsers. Therefore, even though not every single word recited within claim 1 is found exactly within Exhibit B, it is clear that Applicants possessed the invention recited within claims 1 and 3 prior to March 22, 2001.

Claims 10 and 12 are adequately supported by Exhibit B, because the same steps are recited as those in claims 1 and 3. The difference is that claims 10 and 12 recite a computer program product for performing these steps. However, it is well known that it is software implemented within cell phones that can perform such functions.

Claim 16 is also supported by Exhibit B, since pushing content to a microbrowser on a WAP enabled phone would be implemented by downloading a web page to the web-enabled phone while the phone was in a voice conversation after the cell phone was connected over a telecommunications network to a telephone extension. For a microbrowser on a telephone to display such a web page, it would have to use a database storing html code.

The same is true for claims 21 and 24, since it would have been obvious for such actions to be performed over the digital telecommunications network through a

public switched telephone network coupled to the switch that is coupled to the web enabled telephone. In other words, even though not each and every particular element of claim 21 is found within Exhibit B, the features not found are obvious parts of a wireless digital telecommunications network that connects telephones to supported WAP enabled cell phones.

Again, MPEP § 715.02 does not require that each and every word within a rejected claim be found somewhere within the evidence supporting Applicants' efforts to swear behind a reference, if such elements would have been obvious to one skilled in the art. Unless the Examiner can show what elements would not have been obvious to one skilled in the art, the Examiner cannot adequately overcome Applicants' declarations to swear behind the McCormack reference for these particular claims.

The last disagreement between the Examiner and Applicants is with respect to the proof of diligence between the critical date and the constructive reduction to practice. The Examiner and Mr. Tsang have only expressed concern over the period between the critical date of March 21, 2001 and April 11, 2001 when a letter was sent from IBM patent counsel to Mr. Kelly K. Kordzik with instructions to prepare the above-identified patent application.

First, the Examiners are under the mistaken belief that Applicants must show a piece of evidence having a date previous to March 22, 2001. This is not true. In fact, for Applicants to be forced to show such a piece of evidence having an actual date, that would frustrate the purpose of the rule whereby Applicants do not have to disclose actual dates previous to the critical date to show conception. MPEP § 715.07. Under 37 C.F.R. § 1.31, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with a date of a reduction to practice, either actual or constructive. MPEP § 715.07(a). Therefore, the first date of importance is March 21, 2001, which has been established because Applicants have proven that they conceived of the invention prior to March 22, 2001. It is not necessary that Applicants show any type

of dated evidence prior to March 22, 2001, except that Applicants were diligent from March 21, 2001 going forward until they filed their patent application. Since the Examiners have apparently agreed that Applicants have shown diligence at least between April 11, 2001 and the filing date of the above-identified patent application, then the only disagreement as to whether diligence has been shown is with respect to the period of time between March 21, 2001 and April 11, 2001.

Though Applicants believe that there is no need to show such diligence, because this period of time is so short, Applicants hereby submit with this amendment, the declaration of Volel Emile, IBM in-house patent counsel during that period of time, who swears as to the process typically used by IBM Corp. for receiving invention disclosures from inventors and determining which of such invention disclosures become filed as patent applications. The declaration by Mr. Emile describes the typical processes used by IBM Corp. for receiving invention disclosures, such as the one indicated by previously submitted Exhibits A and B, evaluating such invention disclosures for determining which to file as patent applications, and deciding which outside patent counsel to send the invention disclosure for preparation as a patent application. As the Examiners surely appreciate, since IBM Corp. has led the world in issued United States Patents for the past several years, IBM Corp. implements a very definitive and repeatedly used process for evaluating invention disclosures for filing as patent applications. Because of the numerous invention disclosures submitted by IBM employees, and because many of such invention disclosures are eventually filed as patent applications, it can surely be appreciated that a period of several weeks will pass between the submission of an invention disclosure and the letter sent to outside patent counsel to begin the preparation of the patent application. Because this process used by IBM has been in implementation for many years, it is one that can be relied upon as a diligent process.

By the foregoing arguments and evidence, Applicants respectfully assert that they have adequately shown they conceived of the invention recited within the independent claims, and some of the dependent claims, previous to the filing date of

the McCormack reference used by the Examiner for the Section 102 rejections. Applicants also assert that they have adequately shown diligence between the critical date of March 21, 2004 and the date for filing the above-identified patent application of June 27, 2001. As such, Applicants respectfully assert that all of the Section 102 rejections of the claims based on the McCormack reference must be removed, since none of the rejections can stand if the rejections of the independent claims cannot stand.

Applicants again appreciate the time and effort expended by the Examiner and Mr. Tsang in reviewing this matter, and would greatly appreciate the Examiner telephoning Applicants' attorney should any additional information be required or any action taken other than removal of the rejections based on the McCormack reference.

Respectfully submitted,

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